

PRE-APPEAL BRIEF REQUEST FOR REVIEW
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	
)	Examiner: Truvan, Leynna Thanh
Brickell, et al.)	
)	Art Unit: 2435
Application No: 10/686,343)	
)	Confirmation No: 7197
Filed: October 14, 2003)	
)	
For: METHOD FOR SECURELY)	
DELEGATING TRUSTED PLATFORM)	
<u>MODULE OWNERSHIP</u>)	

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Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Final Office Action mailed December 23, 2008, and in conjunction with the Notice of Appeal filed concurrently herewith, Applicant respectfully requests review of the Final rejection of the claims of the above referenced application in view of the following.

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April 23, 2009 _____
Date of Deposit

/Gigi Hoover/ _____
Gigi Hoover

REMARKS

Claims 1, 2, 4-10, 12-18 and 20 are pending in the above-referenced patent application, of which claims 1, 9 and 17 are independent claims. These independent claims are the main subject of this Request. These claims were finally rejected in the Final Office Action mailed December 23, 2008 (hereinafter "office action") under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, and under 35 U.S.C. § 103(a) as being unpatentable over US 7,350,204 to Lambert et al. (hereinafter Lambert) in view of US 7,194,762 to Challener et al. (hereinafter Challener).

Claims 1-2, 4-10, 12-18 and 20 rejection under 35 U.S.C. §112, first paragraph

Claims 1-2, 4-10, 12-18 and 20 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Independent claims 1 and 9, from which claims 2, 4-8, 10 and 12-16 depend, include the element, *"the delegated environment is an environment to which the master owner token is not communicated."* Independent claim 17, from which claims 18 and 20 depend, recites a similar element. The office action states that the *"specification does not limit the claimed the delegated environment is an environment to which the master owner token is not communicated."* (See office action, p. 6, second paragraph.)

On the contrary, the specification does indeed support the claimed element, *"wherein the delegated environment is an environment to which the master owner token is not communicated."* Citing § 2163 of the M.P.E.P.,

"To comply with the written description requirement of 35 U.S.C. 112, para. 1 each claim limitation must be **expressly, implicitly**, or inherently supported in the originally filed disclosure. When an explicit limitation in a claim "is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation." *Hyatt v. Boone*, 146 F.3d 1348, 1353, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998)." (§ 2163 of the M.P.E.P. Emphasis added.)

The Applicants respectfully assert that the element, “*wherein the delegated environment is an environment to which the master owner token is not communicated,*” is present in the originally filed written description both expressly and implicitly. The specification states:

“In one embodiment, there is correspondence between environments and tokens. An environment controls a token (master or delegate) if that environment is the only environment that is given access to that token.” In an example, “an environment can control a token by having the user input the token into the environment.” (See Applicants’ specification, p. 6, lines 23-29.)

It follows that, in the embodiment disclosed, if a master token were communicated to a delegated environment, either the master token would no longer be a master token, as defined above, or the delegated environment would no longer be a delegated environment, as is also defined above. That is, the master owner token is not communicated to the delegated environment. Thus, there is explicit support for the claimed element, “*wherein the delegated environment is an environment to which the master owner token is not communicated.*”

Furthermore, in the embodiment disclosed, an environment can control a token by having the user input the token into the environment, as recited above. One of ordinary skill in the art at the time would have understood that user input of a token to an environment is a form of communication of the token to the environment. The user input and, hence, the communication is limited by the definitions above for types of tokens and corresponding environments, as disclosed in the specification. For example, if a master token were input by a user to a delegated environment, either the master token would no longer be a master token, as defined above, or the delegated environment would no longer be a delegated environment, as is also defined above. That is, the master owner token is not communicated to the delegated environment. Accordingly, there is implicit support for the claimed element, “*wherein the delegated environment is an environment to which the master owner token is not communicated.*” Thus, claims 1-2, 4-10, 12-18 and 20 comply with the written description requirement.

Accordingly, the Applicants respectfully request the Examiner to remove the rejection of claims 1-2, 4-10, 12-18 and 20.

Claims 1-2, 4-10, 12-18, and 20 rejection under 35 U.S.C. §103(a)

Claims 1-2, 4-10, 12-18, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lambert in view of Challenger.

Independent claims 1 and 9, from which claims 2, 4-8, 10 and 12-16 depend, include the element, ***“the delegated environment is an environment to which the master owner token is not communicated.”*** Independent claim 17, from which claims 18 and 20 depend, recites a similar element.

The office action relies solely on Lambert to disclose the portion of the claims that state, i.e. to anticipate the element, *“wherein the delegated environment is an environment to which the master owner token is not communicated.”* However, Lambert fails to anticipate this element. Citing § 2131.01 of the M.P.E.P.,

“‘A claim is anticipated only if each and every element as set forth in the claim is found, **either expressly or inherently described**, in a single prior art reference.’” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).” (§ 2163 of the M.P.E.P. Emphasis added.)

Thus, if a single reference is used to reject an element of a claim, that single reference must disclose the element either expressly or inherently. Lambert does neither. The office action points out, Lambert *“does not suggest the parent token is communicated to the delegated environment since the focus is the restricted token that is associated to a process/software.”* (See office action, p. 8, first paragraph.) However, **the lack of suggestion referred to by the office action is certainly not an explicit disclosure** that the parent token of Lambert is not communicated to the delegated environment, because it is not stated explicitly that this is the case. Furthermore, **the lack of suggestion in Lambert is also not an inherent disclosure** that the parent token of Lambert is not communicated to the delegated environment, because none of the technical features disclosed by Lambert would restrict the parent token of Lambert from being communicated to the delegated environment. Accordingly Lambert fails to disclose *“wherein the delegated environment is an environment to which the master owner token is not communicated,”* as taught and claimed by the Applicants.

Challenger is relied on merely to disclose *“a method and system for improved security password-based access to computer networks,”* including the use of a *“a Trusted Platform*

Module.” (See office action, p. 8, second paragraph.) As such, Challenger fails to cure the above-noted deficiencies of Lambert. Thus, **neither Lambert nor Challenger, alone or in combination, discloses “the delegated environment is an environment to which the master owner token is not communicated,”** as taught and claimed by the Applicants.

Accordingly, the Applicants respectfully request the Examiner to remove the rejection of claims 1-2, 4-10, 12-18 and 20.

Respectfully submitted,
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